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APR 11 2006

**OFFICE OF PETITIONS**

In re Application of : DECISION  
Breivik :  
Application No. 09/831,536 :  
Filing Date: 3 July, 2001 :  
Attorney Docket No.: 7885.76USWO :

This is a revised decision on the petition filed on 9 November, 2004, alleging unavoidable delay under 37 C.F.R. §1.137(a), and, in light of Petitioner's averments and record information, considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter—it was received in the Office of Petitions only as of this writing.

**NOTE:**

Docketing of Status Inquiries at three- (3-) month intervals following the filing of papers/replies may be prudent practice to demonstrate diligence when lengthy delays occur in matters such as this.

Moreover, proper monitoring of the status of one's applications on Private PAIR will inform one's management of application replies and provide one an indication when mailings of Office actions should be expected.

Petitioner should note the reply-time information set forth at the end of this decision.

For the reasons set forth below:

- the petition as considered under 37 C.F.R. §1.181 is **GRANTED**; and
- the petition under 37 C.F.R. §1.137(a) is **DISMISSED as moot**; the petition fee is waived and has not been charged.

#### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a non-final Office action mailed on 3 October, 2003 (a copy is enclosed herewith), with reply due absent extension of time on or before Monday, 5 January, 2004;
- the application went abandoned after midnight 3 January, 2004;
- the Office mailed the Notice of Abandonment on 9 September, 2004;
- on 9 November, 2004, Petitioner filed the instant petition under 37 C.F.R. §1.137(a), and further alleged that—while Petitioner filed, *inter alia*, a Notice of Change of Address on 15 October, 2001, the Office action in question was mailed to an incorrect address on 3 October, 2003;
- a review of the record reveals that Petitioner indeed filed a separate and distinct paper on 15 October, 2001, as a Notice of Change of Address, however, this data seems not have been entered into Office records until Petitioner re-Noticed the Office on 13 September, 2004;
- Petitioner's further showing in this matter approximates the requirements outlined at MPEP §711.03(c).

It is noted that the Examiner provided to Petitioner via FAX a copy of the 3 October, 2003, non-final Office action on 8 November, 2004.

#### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>)

#### Allegations as to the Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Petitioner has satisfied the Delgar requirements.

As to Allegations  
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and--where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

CONCLUSION

Petitioner has satisfied the burdens set forth in Delgar v. Schulyer, and so the petition as considered under 37 C.F.R. §1.181 hereby is granted.

The petition under 37 C.F.R. §1.137(a) is dismissed as moot.

**Petitioner has a three- (3) month shortened statutory period to reply to the 3 October, 2003, non-final Office action (copy enclosed). Extensions of time are available pursuant to under 37 C.F.R. §1.136.**

The instant application is released to Technology Center 1600 to await Petitioner's timely reply to the Office action in question.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

Encl.: Copy of the 3 October, 2003, non-final Office action



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,536	07/03/2001	Jarle Breivik	7885.76USWO	5960
7590	10/03/2003		EXAMINER	
Merchant & Gould 3100 Norwest Center 90 South Seventh Street Minneapolis, MN 55402-4131				ZHOU, SHUBO
		ART UNIT	PAPER NUMBER	
		1631		

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/831,536	BREIVIK, JARLE
	Examiner Shubo "Joe" Zhou	Art Unit 1631

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) filed 7/3/01 and 7/6/01 6) Other:
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)

### **Detailed Action**

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

#### ***Information Disclosure Statement***

The Information Disclosure Statements filed 7/3/01 and 7/24/01 have been entered and considered. Initialed copies of the form PTO-1449 are enclosed with this action.

Further, the references cited on the International Search Report have been considered.

#### ***Specification***

The disclosure is objected to because of the following informalities:

It is noted that the specification is not provided per the guidelines as set forth in 37 CFR 1.77(b). The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37 CFR 1.96(c) and MPEP § 608.05, if the application was filed before March 1, 2001. The total number of microfiche and the total number of frames should be specified. Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation by reference of the material on the compact disc.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

(j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.

(k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.

(l) Sequence Listing, if on paper: See 37 CFR 1.821-1.825.

The disclosure is objected to because it has not been presented in the format above, with section headings for each section.

The use of bracket <<>> in the specification is confusing in multiple places, e.g. << for demonstration in investigating physico-mechanical properties of solids>> on page 3, lines 13-14, <<life>> on page 5, line 26, and <<life>>, <<freed>> and <<species>> on page 15, lines 5-6. It is not clear what the brackets mean.

Appropriate correction is required.

***Claim Rejections-35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The phrase “the interelemental bindings” recited in claim 1 and its dependent claims lacks clear antecedent basis. No “binding” or “bindings” is recited earlier in the claim. Thus, the metes and bounds of the claim are unclear because it is not clear to what the term “bindings” is specifically referred. “Connect” is recited but it is unclear whether the “bindings” refers to the connection.

Claim 9 recites the phrase “the controlling device”. However, no controlling device is recited earlier in the claim, nor in claim 8 from which claim 9 depends.

Claim 9 recites a broad limitation "a programmable unit", followed by "e.g." and a narrower limitation "computer". A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). See also MPEP § 2173.05(d).

Claim 10 is construed as a "use claim", which attempts to claim a process of using the system in claim 1 without setting forth any active, positive steps delimiting how this use is actually practiced. This renders the claim indefinite. See MPEP § 2173.05(q).

Claims 2-8 are rejected due to their dependency from claim 1 and containing the indefinite limitations.

Clarification of the metes and bounds of the claims is requested.

***Claim Rejections-35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 10 is construed as a "use claim", which attempts to claim a process of using the system in claim 1. However, the claim does not set forth any active, positive steps delimiting how this use is actually practiced. Thus, the claim is not a proper process claim under 35 U.S.C. 101. See MPEP § 2173.05(q).

### ***Conclusion***

**No claim is allowed.**

*The claimed invention, at least for the base claim 1, is construed as being a system of elements which are floating in a liquid and reversibly bind to each other, AND that the inter-elemental bindings involve magnetic materials whose Curie points are within a temperature range corresponding to the temperature changes in the environment of the elements. While the specification does not explicitly define the term environmental temperature, it does discuss "room temperature" (page 7, line 21), and give an example of "from 10°C to 40°C" on page 8, line 18. Thus, the range of environmental temperature is interpreted as the changes of room temperature including changes "from 10°C to 40°C".*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located

in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is 703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.



Shubo "Joe" Zhou, Ph.D.

Patent Examiner